

### REMARKS

Claims 1-26 are presented for examination. Claims 1, 3, 4, 8, 10, 11, and 20 have been amended to define more clearly what Applicant regards as his invention. Claims 1, 4, 8, and 11 are in independent form. Favorable reconsideration is requested.

Applicant notes with appreciation the indication that Claims 2 and 9 would be allowable if rewritten so as not to depend from a rejected claim, and with no change in scope. Since the recitations of Claims 2 and 9 have been incorporated into Claims 1 and 8, respectively, while removing any redundancy, Claims 1 and 8 are now believed to be in condition for allowance.

At paragraph 2 of the Office Action, Claims 4 and 11 were objected to because of an informality. The Office Action states:

The claims do not make clear which extracting step the final limitation is referring to in that "said extracting step" could refer to either "extracting a length" or "extracting the inserted message". For purposes of prior art rejection, said extracting step has been construed as referring to "extracting the inserted message".

Claims 4 and 11 have been amended to even further clarify that the step of extracting a length of an inserted message includes a step of generating a key which depends on an initial key and on an assumed length for the inserted message from the set of length values. Applicant notes that this is contrary to the Examiner's interpretation of Claims 4 and 11 for the purposes of the prior art rejections.

Claims 1, 3, 8, 10, 15, and 17-22 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,442,283 to *Tewfik*. Claims 1, 3, 8, 10, 15, and 17-22

were rejected under 35 U.S.C. § 103(a) as being obvious from *Tewfik* in view of U.S.

Patent 5,889,868 to *Moskowitz*; and Claims 4-7, 11-14, 16-18, and 23-26, as being obvious from U.S. Patent 6,104,826 to *Nakagawa* in view of U.S. Patent 6,693,965 to *Inoue*.

First, Claims 1 and 8 are now believed to be in condition for allowance, for the reasons discussed above.

Applicant submits that independent Claims 4 and 11, together with the remaining claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

Claim 4 is directed to a method for extracting a message from digital data representative of physical quantities, the message including ordered symbols. The method includes the steps of (1) segmenting the data into regions, (2) extracting a length of an inserted message, from a set of length values, based on the digital data, and (3) extracting the inserted message. The step of extracting a length of an inserted message includes a step of generating a key which depends on an initial key and on an assumed length for the inserted message from the set of length values.

One notable feature of Claim 4 is a step of extracting a length of an inserted message including generating a key which depends on an initial key and on an assumed length for the inserted message from the set of length values (see, e.g., the present specification at page 12, lines 18-20)<sup>1/</sup>.

To establish a *prima facie* case of obviousness, three basic

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<sup>1/</sup>It is of course to be understood that the references to various portions of the present application are by way of illustration and example only, and that the claims are not limited by the details shown in the portions referred to.

criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143.

The general nature of *Nakagawa* has been discussed adequately in previous papers, and it is not believed to be necessary to repeat that discussion.

In *Nakagawa*, the length of the message is known in advance in the extracting process as discussed in columns 13 and 14, cited by the Examiner. Consequently, *Nakagawa* cannot teach or suggest a step of “extracting a length of an inserted message,” let alone the generation of a key in such a step. Indeed, the Examiner concedes, at page 11 of the office Action, that *Nakagawa* “does not disclose segmenting the data into regions or that the extracting step includes generating a key which depends on an initial key and on an assumed length for the inserted message from the set of length values.”

Even assuming *arguendo* that a combination of *Nakagawa* and *Inoue* would even be permissible, *Inoue* would not supply what is missing from *Nakagawa*.

*Inoue*, as understood by Applicant, relates to embedding and extracting digital information. A secondary key is used to specify which block is to be used for embedding a given bit message (see column 25, lines 53-56) in order to improve the security with respect to tampering (see column 26, lines 48-54). However, as in *Nakagawa*, in *Inoue* the length of the message is known in advance; in particular, in *Inoue*

the length of the message is referred to as Y in Fig. 12 and in column 26, lines 16-32 (for example). Consequently, as with *Nakagawa*, *Inoue* cannot therefore teach or suggest a step of “extracting a length of an inserted message,” and cannot, therefore, teach or suggest any solution to allow an extraction of the length of a message or the generation of a key, as recited in claim 4.

As explained above, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Nothing in *Nakagawa* or *Inoue*, whether considered either separately or in any permissible combination (if any) would teach or suggest that a length of a message can be extracted by a step including the generation of a key, as recited in Claim 4.

Accordingly, Claim 4 is seen to be patentable over *Nakagawa* and *Inoue*, whether considered either separately or in any permissible combination (if any).

Independent Claim 11 recites features similar in many relevant respects to those discussed above with respect to Claim 4 and therefore is also believed to be patentable over *Nakagawa* and *Inoue* for at least the reasons discussed above.

A review of the other art of record has failed to reveal anything which, in Applicant’s opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of

the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ra DiPerna', written over a horizontal line.

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